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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,646	10/09/2001	Tetsuo Nishikawa	Nanjo C-1	6210

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FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 Rambling Road
Kalamazoo, MI 49008-1699

EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,646

Applicant(s)

NISHIKAWA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,12 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,12,16-19,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 9/13/04.

The new grounds of rejection as set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-7, 12, 16-19, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakaki et al. (U.S. 6,364,422).

The rejection is adequately set forth in paragraph 4 of the office action mailed 6/11/03 and is incorporated here by reference.

Although there is no disclosure in Sakaki et al. of at least one member selected from the group consisting of steel, brass, copper, etc., it is noted that the use of such member is optional in claims 22 and 23.

4. Claims 1, 4-7, 16-19, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Gallucci et al. (U.S. 6,300,399).

The rejection is adequately set forth in paragraph 4 of the office action mailed 12/23/03 and is incorporated here by reference.

With respect to newly added claims 22 and 23 which each recite “consisting essentially of” transitional language, it is noted that Gallucci et al. require the use of polyester in addition to tungsten and styrene-based elastomer. However, while it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. polyester, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention. See MPEP 2111.03.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallucci et al. (U.S. 6,300,399) in view of Sakaki et al. (U.S. 6,364,422).

The rejection is adequately set forth in paragraph 4 of the office action mailed 6/11/03 and is incorporated here by reference.

7. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaki et al. (U.S. 6,364,422) in view of Gallucci et al. (U.S. 6,300,399).

The rejection is adequately set forth in paragraph 7 of the office action mailed 12/23/03 and is incorporated here by reference.

Response to Arguments

8. Applicants' arguments regarding Kawamura et al. (U.S. 5,908,884) have been fully considered but they are moot in view of the discontinuation of the use of this reference against the present claims.

9. Applicants' arguments filed 9/13/04 have been fully considered but, with the exception of arguments relating to Kawamura et al., they are not persuasive.

(a) Examiner had previously argued that the 1.131 declaration submitted by applicants to establish reduction to practice of the present invention prior to the earliest US filing date of Gallucci et al. was ineffective to overcome the rejections utilizing Sakaki et al. or Gallucci et al. given that evidence submitted was insufficient to establish diligence from a date prior to the date of reduction to practice of the Sakaki et al. or Gallucci et al. reference to either a constructive reduction to practice or an actual reduction to practice. It was the examiner's position that given that applicants did not rely upon JP 11-95712 when filing the US application, applicants had not established constructive reduction to practice.

In response, in the amendment filed 9/13/04, applicants point to MPEP 715.07 which deals with ways to show prior invention in 1.131 declarations, and argue that applicants' 1.131 declaration is effective given that this portion of the MPEP states that if the declaration presents

facts which show reduction to practice of the invention prior to the effective date of the reference, consideration of the conception of the invention is not applicable.

However, applicants are reminded that according to 37 CFR 1.131(b), applicants must establish reduction to practice prior to the earliest effective date of 8/27/99 of the Gallucci and Sakaki prior art references or conception of the invention coupled with due diligence from prior to the earliest effective date to a subsequent reduction to practice or to the filing of the invention.

Applicants argue that a 1.131 affidavit directed to a certified English translation of JP 11-95712 is evidence of reduction to practice. The examiner disagrees. As set forth in the preceding Office action, it is the examiner's position that JP 11-95712 used by applicant shows conception not reduction to practice of his invention. To show constructive reduction to practice, the applicants' conception must be coupled with due diligence as set forth in 37 CFR 1.131(b) cited above.

Contrary to applicants' arguments, the certified English translation is not evidence of reduction to practice. Rather, it only serves to confirm evidence of conception of applicants' invention. There is no evidence of record which shows due diligence which is necessary along with conception to establish reduction to practice. That is, there is no data between the date of JP '712 and the filing date of the US application that shows the required diligence. In fact, as it stands at present, applicants' constructive reduction to practice occurred on the filing date of his US application not before.

While not directed to the same fact pattern as in the present case, it is helpful to review the Court's decision in *In re Costello* 219 USPQ 389. In that case, the applicant filed a 1.131

affidavit arguing that filing of a parent application constituted reduction to practice for the continuing application even though the parent was abandoned prior to the filing of the continuation. In reversing the applicant, the Federal Circuit held that "The filing of the original application is, however, evidence of conception of the invention. Appellants were able to reduce the invention to writing. That writing therefore constitutes documentary evidence that appellants had conceived of the invention as of the filing date. As the board found, however, appellants did not establish diligence in reducing the invention to practice."

Given that the Federal Circuit did not find persuasive a 1.131 affidavit alleging reduction to practice as having occurred with the filing of the parent case where the applicant could not legitimately claim the benefit of the filing date of the parent case due to lack of diligence, the present situation in which applicant did not (and could not) claim foreign priority and cannot establish due diligence from the date of JP '712 appears to be on even more solid grounds as regards refuting applicant's 1.131 affidavit alleging reduction to practice.

(b) With respect to present claims 16-19, examiner had previously argued that the evidence submitted in the 1.131 declaration, namely copy of JP 11-95712 and its English translation, is insufficient to establish conception and reduction to practice of the invention prior to the effective date of either Sakaki et al. or Gallucci et al. given that the 1.131 declaration is not commensurate in scope with the scope of claims 16-19. That is, present claims 16-17 disclose additional component added to the thermoplastic resin composition while claims 18-19 disclose additional component added to the molded article. However, there is no disclosure in the

evidence or exhibit submitted in the 1.131 declaration of the conception and reduction to practice of thermoplastic resin composition or molded article that requires additional component as required in claims 16-17 or 18-19, respectively. There is no disclosure in JP 11-95712 of the additional ingredient required in present claims 16-19.

In response, applicants argue that page 8 of the English translation of JP 11-95712 states that the thermoplastic resin composition can contain convention additives and that Gallucci et al. provides evidence that the presently claimed metal oxides and sulfates are such conventional additives.

However, the generic disclosure of conventional additives disclosed in JP 11-95712 is very different that the recitation in claims 16-19 of specific metal oxides and sulfates. Further, Gallucci et al.'s disclose that conventional additives include metal oxides and sulfates has no relevance to the present situation especially in view of applicants position that the presently claimed composition and that of Gallucci et al. are different. If the compositions are different, there would be no expectation that conventional additives present in the Gallucci et al. composition are the same conventional additives used in the present invention. Further, Gallucci et al. does not disclose all the additional components required in present claims 16-19 such as copper, aluminum, nickel, silica, silver, etc. There is no evidence that the generically disclosed conventional additives of JP 11-95712 are the same as the specifically claimed metal oxides, metal sulfates, etc. and thus, examiner's position remains that the 1.131 declaration is not commensurate in scope with the scope of present claim 16-19.

(c) Applicants argue that there is no motivation to combine Sakaki et al. with Gallucci et al. given that Sakaki et al. is drawn to flexible resin composition while Gallucci et al. is drawn to high impact resistant composition.

However, it is noted that col.6, lines 8-9 of Gallucci et al. disclose that the composition of Gallucci et al. must also possess good flexibility.

Therefore, given that Gallucci et al. is drawn to composition comprising styrene-based elastomer and tungsten as is Sakaki et al., given that Gallucci et al. disclose that the composition is flexible as is composition of Sakaki et al., and given that there is good motivation to combine Sakaki et al. with Gallucci et al., it is the examiner's position that the combination of Sakaki et al. with Gallucci et al. is proper.

Allowable Subject Matter

10. Claims 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 20-21 would be allowable if rewritten in independent form as described above given that there is no disclosure or suggestion in the "closest" prior art Sakaki et al. (U.S. 6,364,422) or Gallucci et al. (U.S. 6,300,399) of at least one member selected from the group consisting of steel, brass, copper, aluminum, nickel, silver, and zinc.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
11/29/04